

# EXHIBIT G

# Manual of PATENT EXAMINING PROCEDURE

Original Eighth Edition, August 2001  
Latest Revision September 2007



U.S. DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office

The U.S. Patent and Trademark Office does not handle the sale of the Manual, distribution of notices and revisions, or change of address of those on the subscription list. Correspondence relating to existing subscriptions should be sent to the Superintendent of Documents at the following address:

Superintendent of Documents  
Mail List Section  
Washington, DC 20402

Telephone: 202-512-2267

Inquiries relating to purchasing the Manual should be directed to:

Superintendent of Documents  
United States Government Printing Office  
Washington, DC 20402

Telephone: 202-512-1800

Orders for reproduced copies of individual replacement pages or of previous revisions of the Manual should be sent to the following address:

Mail Stop Document Services  
Director of the U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

Telephone: 1-800-972-6382 or 571-272-3150

Previous editions and revisions of the Manual are available on microfilm in the Patent Search Room.

The Manual is available on CD-ROM and on diskette from:

U.S. Patent and Trademark Office  
Office of Electronic Information Products  
MDW 4C18, P.O. Box 1450  
Alexandria, VA 22313-1450

Telephone: 571-272-5600

Employees of the U.S. Patent and Trademark Office should direct their requests for the Manual, replacement pages, notices, and revisions to the Office of Patent Training.

Telephone: 571-272-7222

Pursuant to the Patent and Trademark Office Efficiency Act (PTOEA) (Pub. L. 106-113, 113 Stat. 1501A-572), the head of the United States Patent and Trademark Office (USPTO) is the "Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office." The Director is assisted by the "Deputy Under Secretary of Commerce for Intellectual Property and Deputy Director of the United States Patent and Trademark Office." The patent operations of the USPTO are now headed by the "Commissioner for Patents." The trademark operations of the USPTO are now headed by the "Commissioner for Trademarks." Under section 4741(b) of the PTOEA, any reference to the Commissioner of Patents and Trademarks, the Assistant Commissioner for Patents, or the Assistant Commissioner for Trademarks is deemed to refer to the Director, the Commissioner for Patents, or the Commissioner for Trademarks, respectively. See "Reestablishment of the Patent and Trademark Office as the United States Patent and Trademark Office" published in the *Federal Register* at 65 FR 17858 (Apr. 5, 2000), and in the *Official Gazette of the United States Patent and Trademark Office* at 1234 O.G. 41 (May 9, 2000).

Additions to the text of the Manual are indicated by arrows (><) inserted in the text. Deletions are indicated by a single asterisk (\*) where a single word was deleted and by two asterisks (\*\*) where more than one word was deleted. The use of three or five asterisks in the body of the laws, rules, treaties, and administrative instructions indicates a portion of the law, rule, treaty, or administrative instruction which was not reproduced.

First Edition, November 1949  
Second Edition, November 1953  
Third Edition, November 1961  
Fourth Edition, June 1979  
Fifth Edition, August 1983  
Sixth Edition, January 1995  
Seventh Edition, July 1998  
Eighth Edition, August 2001  
    Revision 1, February 2003  
    Revision 2, May 2004  
    Revision 3, August 2005  
    Revision 4, October 2005  
    Revision 5, August 2006  
    Revision 6, September 2007

## Chapter 700 Examination of Applications

---

<b>701</b>	<b>Statutory Authority for Examination</b>	706.02(h)	Rejections Under 35 U.S.C. 102(g)
<b>702</b>	<b>Requisites of the Application</b>	706.02(i)	Form Paragraphs for Use in Rejections Under 35 U.S.C. 102
702.01	Obviously Informal Cases	706.02(j)	Contents of a 35 U.S.C. 103 Rejection
<b>703</b>	<b>"General Information Concerning Patents"</b>	706.02(k)	Provisional Rejection (Obviousness) Under 35 U.S.C. *103 >Using Provisional Prior Art Under 35 U.S.C. 102(e)<
<b>704</b>	<b>Search and Requirements for Information</b>	706.02(l)	Rejections Under 35 U.S.C. 103(a) Using Prior Art Under Only 35 U.S.C. 102(e), (f), or (g)
704.01	Search	706.02(l)(1)	Rejections Under 35 U.S.C. 103(a) Using Prior Art Under 35 U.S.C. 102(e), (f), or (g); Prior Art Disqualification Under 35 U.S.C. 103(c)
704.10	Requirements for Information	706.02(l)(2)	Establishing Common Ownership or Joint Research Agreement
704.11	What Information May Be Required	706.02(l)(3)	Examination Procedure with Respect to 35 U.S.C. 103(c)
704.11(a)	Examples of Information Reasonably Required	706.02(m)	Form Paragraphs for Use in Rejections Under 35 U.S.C. 103
704.11(b)	When May a Requirement for Information Be Made	706.02(n)	Biotechnology Process Applications; 35 U.S.C. 103(b)
704.12	Replies to a Requirement for Information	706.03	Rejections Not Based on Prior Art
704.12(a)	Relationship of Requirement for Information to Duty of Disclosure	706.03(a)	Rejections Under 35 U.S.C. 101
704.12(b)	What Constitutes a Complete Reply	706.03(b)	Barred by Atomic Energy Act
704.12(c)	Treatment of an Incomplete Reply	706.03(c)	Rejections Under 35 U.S.C. 112, First Paragraph
704.13	Time Periods for Reply	706.03(d)	Rejections Under 35 U.S.C. 112, Second Paragraph
704.14	Making a Requirement for Information	706.03(k)	Duplicate Claims
704.14(a)	Format of the Requirement	706.03(m)	Nonelected Inventions
704.14(b)	Examiner's Obligation Following Applicant's Reply	706.03(o)	New Matter
704.14(c)	Petitions to Requirements Under 37 CFR 1.105	706.03(s)	Foreign Filing Without License
704.14(d)	Relationship to Information Disclosure Statements	706.03(u)	Disclaimer
<b>705</b>	<b>Patentability Reports</b>	706.03(v)	After Interference or Public Use Proceeding
705.01	Instructions re Patentability Reports	706.03(w)	<i>Res Judicata</i>
705.01(a)	Nature of P.R., Its Use and Disposal	706.03(x)	Reissue
705.01(b)	Sequence of Examination	706.04	Rejection of Previously Allowed Claims
705.01(c)	Counting and Recording P.R.s	706.05	Rejection After Allowance of Application
705.01(d)	Duplicate Prints of Drawings	706.06	Rejection of Claims Copied From Patent
705.01(e)	Limitation as to Use	706.07	Final Rejection
705.01(f)	Interviews With Applicants	706.07(a)	Final Rejection, When Proper on Second Action
<b>706</b>	<b>Rejection of Claims</b>	706.07(b)	Final Rejection, When Proper on First Action
706.01	Contrasted With Objections	706.07(c)	Final Rejection, Premature
706.02	Rejection on Prior Art	706.07(d)	Final Rejection, Withdrawal of, Premature
706.02(a)	Rejections Under 35 U.S.C. 102(a), (b), or (e); Printed Publication or Patent	706.07(e)	Withdrawal of Final Rejection, General
706.02(b)	Overcoming a 35 U.S.C. 102 Rejection Based on a Printed Publication or Patent	706.07(f)	Time for Reply to Final Rejection
706.02(c)	Rejections Under 35 U.S.C. 102(a) or (b); Knowledge by Others or Public Use or Sale	706.07(g)	Transitional After-Final Practice
706.02(d)	Rejections Under 35 U.S.C. 102(c)	706.07(h)	Request for Continued Examination (RCE) Practice
706.02(e)	Rejections Under 35 U.S.C. 102(d)		
706.02(f)	Rejections Under 35 U.S.C. 102(e)		
706.02(f)(1)	Examination Guidelines for Applying References Under 35 U.S.C. 102(e)		
706.02(f)(2)	Provisional Rejections Under 35 U.S.C. 102(e); Reference Is a Copending U.S. Patent Application		
706.02(g)	Rejections Under 35 U.S.C. 102(f)		

## MANUAL OF PATENT EXAMINING PROCEDURE

<b>707 Examiner's Letter or Action</b>	
707.01 Primary Examiner Indicates Action for New Assistant	710.02(b) Shortened Statutory Period: Situations in Which Used
707.02 Applications Up for Third Action and 5-Year Applications	710.02(c) Specified Time Limits: Situations In Which Used
707.05 Citation of References	710.02(d) Difference Between Shortened Statutory Periods for Reply and Specified Time Limits
707.05(a) Copies of Cited References	710.02(e) Extension of Time
707.05(b) Citation of Related Art and Information by Applicants	710.04 Two Periods Running
707.05(c) Order of Listing	710.04(a) Copying Patent Claims
707.05(d) Reference Cited in Subsequent Actions	710.05 Period Ending on Saturday, Sunday, or a Federal Holiday
707.05(e) Data Used in Citing References	710.06 Situations When Reply Period Is Reset or Restarted
707.05(f) Effective Dates of Declassified Printed Matter	
707.05(g) Incorrect Citation of References	<b>711 Abandonment of Patent Application</b>
707.06 Citation of Decisions, Orders Memorandums, and Notices	711.01 Express or Formal Abandonment
707.07 Completeness and Clarity of Examiner's Action	711.02 Failure To Take Required Action During Statutory Period
707.07(a) Complete Action on Formal Matters	711.02(a) Insufficiency of Reply
707.07(b) Requiring New Oath	711.02(b) Special Situations Involving Abandonment
707.07(c) Draftsperson's Requirement	711.02(c) Termination of Proceedings
707.07(d) Language To Be Used In Rejecting Claims	711.03 Reconsideration of Holding of Abandonment; Revival
707.07(e) Note All Outstanding Requirements	711.03(a) Holding Based on Insufficiency of Reply
707.07(f) Answer All Material Traversed	711.03(b) Holding Based on Failure To Reply Within Period
707.07(g) Piecemeal Examination	711.03(c) Petitions Relating to Abandonment
707.07(h) Notify of Inaccuracies in Amendment	711.03(d) Examiner's Statement on Petition To Set Aside Examiner's Holding
707.07(i) Each Claim To Be Mentioned in Each Office Action	711.04 Public Access to Abandoned Applications
707.07(j) State When Claims Are Allowable	711.04(a) Pulling and Forwarding Abandoned Applications
707.07(k) Numbering Paragraphs	711.04(b) Ordering of Patented and Abandoned Files
707.07(l) Comment on Examples	711.04(c) Notifying Applicants of Abandonment
707.08 Reviewing and Initialing by Assistant Examiner	711.05 Letter of Abandonment Received After Application is Allowed
707.09 Signing by Primary or Other Authorized Examiner	711.06 Abstracts, Abbreviations, and Defensive Publications
707.10 Entry	711.06(a) Citation and Use of Abstracts, Abbreviations, and Defensive Publications as References
707.11 Date	
707.12 Mailing	
707.13 Returned Office Action	
<b>708 Order of Examination</b>	
708.01 List of Special Cases	<b>713 Interviews</b>
708.02 Petition To Make Special	713.01 General Policy, How Conducted
708.02(a) Accelerated Examination	713.02 Interviews Prior to First Official Action
708.03 Examiner Tenders Resignation	713.03 Interview for "Sounding Out" Examiner Not Permitted
<b>709 Suspension of Action</b>	
709.01 Overlapping Applications by Same Applicant or Owned by Same Assignee	713.04 Substance of Interview Must Be Made of Record
<b>710 Period for Reply</b>	
710.01 Statutory Period	713.05 Interviews Prohibited or Granted, Special Situations
710.01(a) Statutory Period, How Computed	713.06 No Inter Partes Questions Discussed Ex Parte
710.02 Shortened Statutory Period and Time Limit Actions Computed	713.07 Exposure of Other Cases
	713.08 Demonstration, Exhibits, Models

## EXAMINATION OF APPLICATIONS

713.09	Finally Rejected Application	715.01	37 CFR 1.131 Affidavits Versus 37 CFR 1.132 Affidavits
713.10	Interview Preceding Filing Amendment Under 37 CFR 1.312	715.01(a)	Reference Is a Joint Patent or Published Application to Applicant and Another
<b>714 Amendments, Applicant's Action</b>			
714.01	Signatures to Amendments	715.01(b)	Reference and Application Have Common Assignee
714.01(a)	Unsigned or Improperly Signed Amendment	715.01(c)	Reference Is Publication of Applicant's Own Invention
714.01(c)	Signed by Attorney or Agent Not of Record	715.01(d)	Activities Applied Against the Claims
714.01(d)	Amendment Signed by Applicant but Not by Attorney or Agent of Record	715.02	How Much of the Claimed Invention Must Be Shown, Including the General Rule as to Generic Claims
714.01(e)	Amendments Before First Office Action Must Be Fully Responsive	715.03	Genus-Species, Practice Relative to Cases Where Predictability Is in Question
714.02	Amendments Not Fully Responsive, Action To Be Taken	715.04	Who May Make Affidavit or Declaration; Formal Requirements of Affidavits and Declarations
714.03	Supplemental Amendment	715.05	U.S. Patent or Application Publication Claiming Same Invention
714.04	Claims Presented in Amendment With No Attempt To Point Out Patentable Novelty	715.07	Facts and Documentary Evidence
714.05	Examiner Should Immediately Inspect	715.07(a)	Diligence
714.06	Amendments Sent to Wrong Technology Center	715.07(b)	Interference Testimony Sometimes Used
714.07	Amendments Not in Permanent Ink	715.07(c)	Acts Relied Upon Must Have Been Carried Out in This Country or a NAFTA or WTO Member Country
714.10	Claims Added in Excess of Claims Previously Paid For	715.07(d)	Disposition of Exhibits
714.11	Amendment Filed During Interference Proceedings	715.08	Passed Upon by Primary Examiner
714.12	Amendments and other Replies After Final Rejection or Action	715.09	Seasonable Presentation
714.13	Amendments and other Replies After Final Rejection or Action, Procedure Followed	715.10	Review of Affidavit or Declaration for Evidence of Prior Public Use or Sale or Failure to Disclose Best Mode
714.14	Amendments After Allowance of All Claims	<b>716 Affidavits or Declarations Traversing Rejections, 37 CFR 1.132</b>	
714.15	Amendment Received in Technology Center After Mailing of Notice of Allowance	716.01	Generally Applicable Criteria
714.16	Amendment After Notice of Allowance, 37 CFR 1.312	716.01(a)	Objective Evidence of Nonobviousness
714.16(a)	Amendments Under 37 CFR 1.312, Copied Patent Claims	716.01(b)	Nexus Requirement and Evidence of Nonobviousness
714.16(b)	Amendments Under 37 CFR 1.312 Filed With a Motion Under 37 CFR 41.208	716.01(c)	Probative Value of Objective Evidence
714.16(c)	Amendments Under 37 CFR 1.312, Additional Claims	716.01(d)	Weighing Objective Evidence
714.16(d)	Amendments Under 37 CFR 1.312, Handling	716.02	Allegations of Unexpected Results
714.16(e)	Amendments Under 37 CFR 1.312, Entry in Part	716.02(a)	Evidence Must Show Unexpected Results
714.17	Amendment Filed After the Period for Reply Has Expired	716.02(b)	Burden on Applicant
714.18	Entry of Amendments	716.02(c)	Weighing Evidence of Expected and Unexpected Results
714.19	List of Amendments, Entry Denied	716.02(d)	Unexpected Results Commensurate in Scope With Claimed Invention
714.20	List of Amendments Entered in Part	716.02(e)	Comparison With Closest Prior Art
714.21	Amendments Inadvertently Entered, No Legal Effect	716.02(f)	Advantages Disclosed or Inherent
714.22	Discourtesy of Applicant or Attorney	716.02(g)	Declaration or Affidavit Form
<b>715 Swearing Back of Reference — Affidavit or Declaration Under 37 CFR 1.131</b>		716.03	Commercial Success
		716.03(a)	Commercial Success Commensurate in Scope With Claimed Invention

**701****MANUAL OF PATENT EXAMINING PROCEDURE**

- 716.03(b) Commercial Success Derived From Claimed Invention
- 716.04 Long-Felt Need and Failure of Others
- 716.05 Skepticism of Experts
- 716.06 Copying
- 716.07 Inoperability of References
- 716.08 Utility and Operability of Applicant's Disclosure
- 716.09 Sufficiency of Disclosure
- 716.10 Attribution
- 718 Affidavit or Declaration to Disqualify Commonly Owned Patent or Published Application as Prior Art, 37 CFR 1.130**
- 719 File Wrapper**
  - 719.01 Papers in File Wrapper
  - 719.01(a) Arrangement of Papers in File Wrapper
  - 719.01(b) Prints
  - 719.02 Data Entered on File Wrapper
  - 719.02(b) Name or Residence of Inventor or Title Changed
  - 719.03 Classification During Examination
  - 719.04 Index of Claims
  - 719.05 Field of Search
  - 719.06 Foreign Filing Dates
  - 719.07 Related Applications
- 720 Public Use Proceedings**
  - 720.01 Preliminary Handling
  - 720.02 Examiner Determination of *Prima Facie* Showing
  - 720.03 Preliminary Hearing
  - 720.04 Public Use Proceeding Testimony
  - 720.05 Final Decision
- 724 Trade Secret, Proprietary, and Protective Order Materials**
  - 724.01 Completeness of the Patent File Wrapper
  - 724.02 Method of Submitting Trade Secret, Proprietary, and/or Protective Order Materials
  - 724.03 Types of Trade Secret, Proprietary, and/or Protective Order Materials Submitted Under MPEP § 724.02
  - 724.04 Office Treatment and Handling of Materials Submitted Under MPEP § 724.02
  - 724.04(a) Materials Submitted in an Application Covered by 35 U.S.C. 122
  - 724.04(b) Materials Submitted in Reissue Applications Open to the Public Under 37 CFR 1.11(b)
  - 724.04(c) Materials Submitted in Reexamination File, Open to the Public Under 37 CFR 1.11(d)
  - 724.05 Petition To Expunge Information or Copy of Papers in Application File
  - 724.06 Handling of Petitions to Expunge Information or Copy of Papers in Application File

**701 Statutory Authority for Examination***35 U.S.C. 131. Examination of application.*

The Director shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Director shall issue a patent therefor.

The main conditions precedent to the grant of a patent to an applicant are set forth in 35 U.S.C. 101, 102 and 103.

*35 U.S.C. 101. Inventions patentable.*

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Form paragraph 7.04 copies 35 U.S.C. 101. See MPEP § 706.03(a).

*35 U.S.C. 100. Definitions.*

When used in this title unless the context otherwise indicates -

- (a) The term "invention" means invention or discovery.
- (b) The term "process" means process, art, or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.
- (c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.
- (d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.
- (e) The term "third-party requester" means a person requesting ex parte reexamination under section 302 or *inter partes* reexamination under section 311 who is not the patent owner.

**702 Requisites of the Application [R-3]**

When a new application is assigned in the Technology Center, the examiner should review the contents of the application to determine if the application meets the requirements of 35 U.S.C. 111(a). Any matters affecting the filing date or abandonment of the application, such as lack of an oath or declaration, filing fee, or claims should be checked \*\*. For Image File Wrapper (IFW) processing, see IFW Manual sections 3.1 and 3.3.

The examiner should be careful to see that the application meets all the requisites set forth in MPEP Chapter 600 both as to formal matters and as to the completeness and clarity of the disclosure. If all of the requisites are not met, applicant may be called upon

**716.01(b)****MANUAL OF PATENT EXAMINING PROCEDURE**

147, 87 USPQ 303 (1950). See *Dann v. Johnston*, 425 U.S. 219, 226 n.4, 189 USPQ 257, 261 n. 4 (1976).

Examiners must consider comparative data in the specification which is intended to illustrate the claimed invention in reaching a conclusion with regard to the obviousness of the claims. *In re Margolis*, 785 F.2d 1029, 228 USPQ 940 (Fed. Cir. 1986). The lack of objective evidence of nonobviousness does not weigh in favor of obviousness. *Miles Labs. Inc. v. Shandon Inc.*, 997 F.2d 870, 878, 27 USPQ2d 1123, 1129 (Fed. Cir. 1993), *cert. denied*, 127 L. Ed. 232 (1994). However, where a *prima facie* case of obviousness is established, the failure to provide rebuttal evidence is dispositive.

### **716.01(b) Nexus Requirement and Evidence of Nonobviousness**

#### **TO BE OF PROBATIVE VALUE, ANY SECONDARY EVIDENCE MUST BE RELATED TO THE CLAIMED INVENTION (NEXUS REQUIRED)**

The weight attached to evidence of secondary considerations by the examiner will depend upon its relevance to the issue of obviousness and the amount and nature of the evidence. Note the great reliance apparently placed on this type of evidence by the Supreme Court in upholding the patent in *United States v. Adams*, 383 U.S. 39,148 USPQ 479 (1966).

To be given substantial weight in the determination of obviousness or nonobviousness, evidence of secondary considerations must be relevant to the subject matter as claimed, and therefore the examiner must determine whether there is a nexus between the merits of the claimed invention and the evidence of secondary considerations. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 305 n.42, 227 USPQ 657, 673-674 n. 42 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986). The term "nexus" designates a factually and legally sufficient connection between the objective evidence of nonobviousness and the claimed invention so that the evidence is of probative value in the determination of nonobviousness. *Demaco Corp. v. F. Von Langsdorff Licensing*

*Ltd.*, 851 F.2d 1387, 7 USPQ2d 1222 (Fed. Cir.), *cert. denied*, 488 U.S. 956 (1988).

### **716.01(c) Probative Value of Objective Evidence [R-2]**

>

#### **I. < TO BE OF PROBATIVE VALUE, ANY OBJECTIVE EVIDENCE SHOULD BE SUPPORTED BY ACTUAL PROOF**

Objective evidence which must be factually supported by an appropriate affidavit or declaration to be of probative value includes evidence of unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant. See, for example, *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984) ("It is well settled that unexpected results must be established by factual evidence." "[A]ppellants have not presented any experimental data showing that prior heat-shrinkable articles split. Due to the absence of tests comparing appellant's heat shrinkable articles with those of the closest prior art, we conclude that appellant's assertions of unexpected results constitute mere argument."). See also *In re Lindner*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991).

>

#### **II. < ATTORNEY ARGUMENTS CANNOT TAKE THE PLACE OF EVIDENCE**

The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). Examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration include statements regarding unexpected results, commercial success, solution of a long-felt need, inoperability of the prior art, invention before the date of the reference, and allegations that the author(s) of the prior art derived the disclosed subject matter from the applicant.

## EXAMINATION OF APPLICATIONS

716.01(d)

See MPEP § 2145 generally for case law pertinent to the consideration of applicant's rebuttal arguments.

&gt;

**III. <OPINION EVIDENCE**

Although factual evidence is preferable to opinion testimony, such testimony is entitled to consideration and some weight so long as the opinion is not on the ultimate legal conclusion at issue. While an opinion as to a legal conclusion is not entitled to any weight, the underlying basis for the opinion may be persuasive. *In re Chilowsky*, 306 F.2d 908, 134 USPQ 515 (CCPA 1962) (expert opinion that an application meets the requirements of 35 U.S.C. 112 is not entitled to any weight; however, facts supporting a basis for deciding that the specification complies with 35 U.S.C. 112 are entitled to some weight); *In re Lindell*, 385 F.2d 453, 155 USPQ 521 (CCPA 1967) (Although an affiant's or declarant's opinion on the ultimate legal issue is not evidence in the case, "some weight ought to be given to a persuasively supported statement of one skilled in the art on what was not obvious to him." 385 F.2d at 456, 155 USPQ at 524 (emphasis in original)).

In assessing the probative value of an expert opinion, the examiner must consider the nature of the matter sought to be established, the strength of any opposing evidence, the interest of the expert in the outcome of the case, and the presence or absence of factual support for the expert's opinion. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986). See also *In re Oelrich*, 579 F.2d 86, 198 USPQ 210 (CCPA 1978) (factually based expert opinions on the level of ordinary skill in the art were sufficient to rebut the *prima facie* case of obviousness); *Ex parte Gray*, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989) (statement in publication dismissing the "preliminary identification of a human b-NGF-like molecule" in the prior art, even if considered to be an expert opinion, was inadequate to overcome the rejection based on that prior art because there was no factual evidence supporting the statement); *In re Carroll*, 601 F.2d 1184, 202 USPQ 571 (CCPA 1979) (expert opinion on what the prior art taught, supported by documentary evidence and formulated prior to the making of the claimed invention, received considerable deference); *In re Beattie*,

974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992) (declarations of seven persons skilled in the art offering opinion evidence praising the merits of the claimed invention were found to have little value because of a lack of factual support); *Ex parte George*, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991) (conclusory statements that results were "unexpected," unsupported by objective factual evidence, were considered but were not found to be of substantial evidentiary value).

Although an affidavit or declaration which states only conclusions may have some probative value, such an affidavit or declaration may have little weight when considered in light of all the evidence of record in the application. *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973).

An affidavit of an applicant as to the advantages of his or her claimed invention, while less persuasive than that of a disinterested person, cannot be disregarded for this reason alone. *Ex parte Keyes*, 214 USPQ 579 (Bd. App. 1982); *In re McKenna*, 203 F.2d 717, 97 USPQ 348 (CCPA 1953).

**716.01(d) Weighing Objective Evidence [R-6]****IN MAKING A FINAL DETERMINATION OF PATENTABILITY, EVIDENCE SUPPORTING PATENTABILITY MUST BE WEIGHED AGAINST EVIDENCE SUPPORTING PRIMA FACIE CASE**

When an applicant timely submits evidence traversing a rejection, the examiner must reconsider the patentability of the claimed invention. The ultimate determination of patentability must be based on consideration of the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The submission of objective evidence of patentability does not mandate a conclusion of patentability in and of itself. *In re Chupp*, 816 F.2d 643, 2 USPQ2d 1437 (Fed. Cir. 1987). Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of a *prima facie* case was reached, not against the conclusion itself. *In re Eli Lilly*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990). In other words, each piece of rebuttal evidence